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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/054,602	04/03/1998	DENNIS EDWARD SMITH	74311ACFR	2765

1333 7590 05/01/2003

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

EXAMINER

REDDICK, MARIE L

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 05/01/2003

24

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/054,602

Applicant(s)

SMITH ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 11, 12, 14-21, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 12, 14-21, 23, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. *The amendment to the claims filed on 02/19/03 has been entered and considered. After an extensive review of the file, new prior art has come to the Examiner's attention and a rejection based on such is deemed proper and is as set forth infra. To this end, the indication of allowability per paper no. 22, 11/21/02 is herein rescinded. An apology is extended to applicants for any inconvenience that this may have caused.*

Claim Objections

2. *Claim 25 is objected to because of the following informalities: In claim 25 @ line 10, "monbutyl maleate" should read "monobutyl maleate", consistent with art-accepted terminology. Appropriate correction is required.*

Claim Rejections - 35 USC § 102

3. *The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. *The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. *Claims 1-4, 11, 12, 14-21, 23 and 26 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bagchi(U.S. 4,920,004).*

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Bagchi teaches polymer particles, useful as a matting agent in a photographic element, wherein said polymer particles are derived from polymers representative of the formula $-(A-x)---(B-x)---100-x$ wherein A represents recurring monomer units derived from carboxylic acids such as (meth)acrylic acid, itaconic acid, maleic acid, etc., B represents recurring monomer units derived from ethylenically unsaturated monomers such as styrene, divinylbenzene, etc. and "x" represents from 0.1 to 100 and preferably from 1-20 mole %. More specifically, Bagchi exemplifies a process for producing polymer particles which involves suspension polymerizing styrene(90 wt.%), methacrylic acid(5 wt.%) and divinylbenzene(5 wt.%) as a dispersed phase suspended in an aqueous phase and in the presence of sodium chloride(33 wt.%, a water-soluble inorganic salt), potassium dichromate(polymerization inhibitor), diethanolamine adipate(promoter) and SiO₂ particles(a water-insoluble particulate stabilizer Ludox AM governed by a particle size falling within the scope of the claims). See Run 3 of Bagchi. Run 3 of Bagchi therefore anticipates the instantly claimed invention with the understanding that one of ordinary skill in the art would have readily envisaged the use of contents of methacrylic acid in amounts falling within the scope of the claims following the guidelines of Bagchi at col. 3, lines 1-24 & 42-57.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

8. *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

9. *Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bagchi(U.S. 4,920,004) in combination with Wiley(U.S. 2,932,629).*

The disclosure of Bagchi for what it teaches and as applied to claims 1-4, 11, 12, 14-21, 23 and 26 is as stated in the rejection supra. Further, the disclosure of Bagchi differs basically from the claimed invention as per the silence of a particulate stabilizer falling within the scope of the claims, viz., a water-insoluble, resinous polymer. However, Wiley teaches the use of commonly known water-insoluble polymers as particulate stabilizers in the suspension polymerization of ethylenically unsaturated monomers such as styrene. Therefore, it would have been obvious to the skilled artisan to use a commonly known particulate stabilizer in the similar such suspension polymerization procedure of Bagchi, and with a reasonable expectation of success. Criticality for such, commensurate in scope with the claims, not having been demonstrated on this record.

Response to Arguments

10. *Applicant's arguments with respect to claims 1-4, 11, 12, 14-21, 23, 25 and now 26 have been considered but said arguments do not address the prior art rejections at hand.*

Conclusion

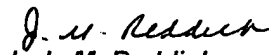
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11. *The prior art to EP 405,872(YANG) is cited as of interest in teaching the use of a water-soluble salt and water-insoluble particulate stabilizer combination in the suspension polymerization of ethylenically unsaturated monomers comprising at least a carboxylic acid monomer and considered merely cumulative to the prior art supra.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
April 29, 2003